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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/836,012

04/17/2001

Jeffrey R. Sampson

10992153-1
(2003309-0013)

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7590

09/02/2004

EXAMINER

CHUNDURU, SURYAPRABHA

AGILENT TECHNOLOGIES, INC.
INTELLECTUAL PROPERTY ADMINISTRATION, LEGAL DEPT.
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LOVELAND, CO 80537-0599

ART UNIT

PAPER NUMBER

1637

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/836,012

Applicant(s)

SAMPSON ET AL.

Examiner

Suryaprabha Chunduru

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) 18-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 74, 75 and 77-80 is/are rejected.
- 7) ☒ Claim(s) 7-17, 76 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3127103 + 2110104
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicants' response to the office action filed on May 10, 2004 has been entered and acknowledged.
2. Claims 1-17, 74-80 are considered for examination. Claims 18-73 are withdrawn as being non-elected claims.

Response to arguments

3. Applicants' arguments to the office action have been fully considered and found persuasive in part.
4. With regard to the rejection made in the previous office action under statutory type double patenting, Applicants' arguments are fully considered and found not persuasive. Applicants argue that the pending claims 1 and 2 recite "wherein the mixture or sub-mixtures further comprises a set of tags wherein each tag is covalently linked to at least one X-mer precursor through a cleavable linker", which is not disclosed in the claims of the '118 patent. Applicants arguments are fully considered and found not persuasive because the claim 6 of the '118 patent disclose that said X-mer precursors of the said mixture or sub-mixture comprise a tag, which inherently teaches that at least one X-mer precursor comprises a tag. Further claim 64-65 of the '118 patent discloses a cleavable linker with a nucleic acid sequence attached to it, which indicate that the claims in the patent encompass the claim language used in the instant claims. Thus the rejection is maintained herein.
5. With regard to the rejection made in the previous office action under non-statutory obviousness-type of double patenting, Applicants' arguments are fully considered and found not persuasive. As discussed above the claims in the '118 patent encompass the

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limitations in the instant claims and as discussed in the earlier office action the instant claims 74, 79, and 80 are related as genus and species. The species as claimed in the patent renders the genus obvious. Thus the rejection is maintained herein.

6. With regard to the objection to claims 7-17 and 76, Applicants' arguments are considered and found not persuasive as discussed above the independent claims 1 and 2 encompass the limitations of the claims in the '118 patent and the objection is maintained herein.

Conclusion

No claims are allowable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Gary Benzion reached on 571-272-0782. The fax phone numbers for the organization where this application or proceeding is assigned are 703872-9306 for regular communications and - for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

SPC
Suryaprabha Chunduru
August 24, 2004

Jehanne Sitton
JEHANNE SITTON
PRIMARY EXAMINER
8/24/04